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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Woessner
Serial No.: 10/501,591
Filed: July 14, 2004
Group Art Unit: Unknown
Examiner: Unknown
Title: HOSE IN TUBE FORMING ASSEMBLY AND PROCESS

RENEWED PETITION UNDER RULE 37 CFR 1.47(b)

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Commissioner for Patents
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Legal Staff
International Division

Dear Sir:

This Renewed Petition under 37 CFR 1.47(b) is in response to the Decision Refusing Status under 37 CFR 1.47(b) dated September 9, 2005. As required by 37 CFR 1.47(b) and stated in the Decision, Applicant has previously submitted a statement of the last known address of Mr. Woessner, the fee under 37 CFR 1.17(h), factual proof that the inventor refuses to execute the application or cannot be reached after diligent effect, an oath or declaration by the 37 CFR 1.47(b) Applicant, Cooper Standard Automotive Inc. (Cooper), on behalf of and as agent for the non-signing inventor and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. The Decision on Petition states that proof that the 37 CFR 1.47(b) Applicant has sufficient proprietary interest in the application is needed.

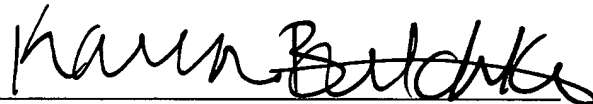
Applicant has sufficient proprietary interest in the application. The reasons for this action are set forth in the enclosed Legal Memorandum.

For the reasons set forth above, assignee submits that the filing of this application under Rule 37 CFR 1.47(b) is proper. Applicant asks that processing of this application now proceed.

The Commissioner is authorized to charge Deposit Account No. 50-1482, in the name of Carlson, Gaskey & Olds, P.C., \$130.00 for the fee required. No additional fees are seen to be required. If any additional fees are due, however, the Commissioner is authorized to charge Deposit Account No. 50-1482, in the name of Carlson, Gaskey & Olds, P.C., for any additional fees or credit the account for any overpayment. Therefore, favorable reconsideration and allowance of this application is respectfully requested.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.



Karin H. Butchko
Registration No. 45,864
Attorneys for Applicant
400 West Maple Road, Suite 350
Birmingham, Michigan 48009
(248) 988-8360

Dated: November 9, 2005

CERTIFICATE OF MAILING

I hereby certify that this Petition and accompanying documents are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450 on November 9, 2005.


Amy Spaulding

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LEGAL MEMORANDUM

I. Applicable Law

Cooper Standard Automotive, Inc. "Cooper," the 37 CFR 1.47(b) applicant, is located in Novi, Michigan. Michigan does not have a statute relating to the ownership of patents, but rather follows the common law. The Michigan Supreme Court has ruled a common law equity action determines ownership of a patent and that an agreement to assign can be inferred from the facts pleaded.¹ The Michigan Supreme Court has also ruled that one employed to make an invention, who succeeds during his term of service, in accomplishing that task, is bound to assign to his employer any patent obtained.² The court in *Gear Grinding* stated the law with respect to this issue is well established by the Supreme Court in the *United States v. Dubilier Condenser Corporation*³, which states:

One employed to make an invention, who succeeds, during his term of service, in accomplishing that task, is bound to assign to his employer any patent obtained. The reason is that he has only produced that which he was employed to invent. His invention is the precise subject of the contract of employment. A term of the agreement necessarily is that what he is paid to produce belongs to his paymaster.

Copies of the three cited cases are attached.

¹ A & C Engineering Company v. Atherholt, 95 N.W.2d 871, 872 (Mi. 1959).

² Gear Grinding Mach. Co. v. Stuber, 276 N.W. 514, 517 (Mi. 1937).

³ 53 S.Ct. 554 (1933).

II. Application of Law

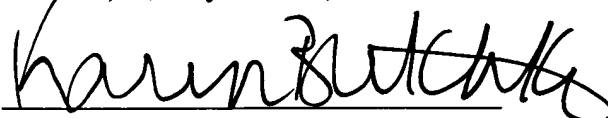
Mr. David Woessner was Senior Process Technician at Cooper. In that capacity, he was responsible for process engineering relating to forming tubes and hoses, as evidenced in the Affidavit executed by Mr. Joseph Zakrzewski, Manager of Product and Process Engineering at Cooper, that was included in the previous Renewed Petition filed on August 24, 2005. Mr. Woessner was employed by Cooper to develop and improve methods of forming tubes and hoses, and therefore he was under an obligation to assign these inventions to Cooper. The subject matter of the present application relates to a method of forming a hose in a tube. Therefore, Cooper has sufficient proprietary interest in the application relating to a method of forming a tube because this is what he was employed to invent.

III. Conclusion

In sum, in Michigan, under the common law, Cooper has sufficient proprietary interest in this patent application. Mr. Woessner was employed to produce inventions relating to forming tubes and hoses during his term of service at Cooper. He succeeded in inventing the present invention relating to a method of forming a hose in a tube during his employment at Cooper. Therefore, as in *Dubilier* above, the invention is the precise subject of his contract of employment and he is bound to assign to Cooper any patent obtained relating to improvements in tubes and hoses, as he produced what he was employed to invent. Therefore, Cooper has sufficient proprietary interest in the application.

Respectfully submitted,

Carlson, Gaskey & Olds, P.C.



Karin H. Butchko
Registration No. 45,864
400 W. Maple Road, Ste. 350
Birmingham, MI 48009
(248) 988-8360

Dated: November 9, 2005